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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,775	06/30/2003	John C. Hill	084.0004X1 (FLORA.1300)	1915
77037	7590	11/18/2009	EXAMINER	
Ingrassia Fisher & Lorenz, P.C. (FLORATECH) 7010 East Cochise Road Scottsdale, AZ 85253-1406			GHALI, ISIS A D	
			ART UNIT	PAPER NUMBER
			1611	
			NOTIFICATION DATE	DELIVERY MODE
			11/18/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@ifllaw.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/611,775	<b>Applicant(s)</b> HILL ET AL.	
	<b>Examiner</b> Isis A. Ghali	<b>Art Unit</b> 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 35-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/17/2009</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

The receipt is acknowledged of applicants' amendment and terminal disclaimer filed 07/13/2009; and IDS filed 06/17/2009.

Claims 1-34 have been canceled.

Claims 35-40 are pending and included in the prosecution.

### ***Terminal Disclaimer***

1. The terminal disclaimer filed on 07/13/2009 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 7,435,424 has been reviewed and is accepted. The terminal disclaimer has been recorded.

**The following rejections have been overcome by virtue of applicants' amendment and remarks:**

(A) Rejection of claims 35-40 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

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(B) Rejection of claims 35-40 under 35 U.S.C. 112, first paragraph, as lacking enablement.

(C) Rejection of claims 35-40 under 35 U.S.C. 112, second paragraph, as being indefinite

**The following rejection has been discussed in details in the previous office action, and is maintained for reasons of record:**

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 35-40 are rejected under 35 U.S.C. 103(a) as being obvious over FR 2471775 ('775) combined with US 6,280,746 ('746).

The applied reference ('764) has a common assignee and one common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104,

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together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

FR '775 teaches cosmetic composition comprising mixture of jojoba oil and sunflower oil, and from 20-40% unsaponifiables oils fractions (page 4, 3<sup>rd</sup> paragraph). The unsaponifiable fraction includes residual part of saponifiable components and unsaponifiable fraction, with the unsaponifiable ingredients is greater than 40% (paragraph bridging pages 4 and 5). The cosmetic composition can be in the form of gel (last paragraph of page 5). Examples 3-5 and 7 showed composition comprising gelling agent Caropol 940, which is an acidic gelling agent.

Although FR '775 teaches composition comprising saponifiable and unsaponifiables fractions obtained from vegetable oils and suggested jojoba oil, however, the reference does not explicitly teach hydrolysis of the oil.

US '746 teaches cosmetic composition comprising jojoba oil ester (abstract). When applied to the skin, the cosmetic composition comprising jojoba oil ester prevents and retains natural moisture level of the skin (col.8, lines 18-24). The composition comprising jojoba oil esters from the trade name Floraesters-15, 20, 30, 60 70 (col.8, lines 35-40). The reference disclosed that jojoba esters are catalyzed, i.e. hydrolyzed, using alkali metal hydroxide, as applicants had done (col.3, lines 53-60). The reference disclosed gel (example 2). The Floraester disclosed by the reference are expected to have polar hydrophilic salt and non-polar unsaponifiable fractions of jojoba oil, and

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expected to comprise more than 10% long chain carbon material prior to hydrolysis.

Hydrolyzed jojoba esters are produced using potassium hydroxide, and therefore they are alkaline and expected to be capable to neutralize acidic gelling agent.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide gel cosmetic composition comprising saponifiable and unsaponifiable oil fractions as disclosed by FR '775, and select jojoba oil suggested by the reference and further use hydrolyzed jojoba oil esters as disclosed by US '746. One would have been motivated to do so because US '746 teaches that cosmetic composition comprising hydrolyzed jojoba ester when applied to the skin prevents and retains natural moisture level of the skin. One would have reasonably expected formulating gel cosmetic composition comprising hydrolyzed jojoba oil comprising saponifiable and unsaponifiable fractions wherein the composition prevents and retains natural moisture level on application to the skin.

### ***Response to Arguments***

6. Applicant's arguments filed 07/13/2009 have been fully considered but they are not persuasive. Applicants argue that Arquette et al. patent is disqualified as a prior art since the present application and Arquette patent were commonly owned by International Flora Technologies, Ltd., at the time the invention of present application was made.

In response to this argument it is argued that Arquette patent, by the same assignee of the present application is qualified as prior art because it has different

inventive entity and it does not disclose the subject matter of the present invention directed to "method of providing a composition for topical application, wherein said composition increases substantivity". See *In re Chu* (CAFC) 36 USPQ2d 1089 (1995). Furthermore, the present application is a CIP of patent 7,435,424 that does not disclose the limitation of the "gel" of subject matter of the present claims. Therefore, the instant claims do not qualified to the priority date 01/03/2000 of 7,435,424 patent. The instant method steps qualify to priority date 06/30/2003, filing date of the present application. Accordingly, Arquette patent that is issued August 28, 2001 has 35 U.S.C. 102 (b) date, and not 35 U.S.C. 102 (e) date, hence qualifies under 35 U.S.C. 103 (a), and can not be overcome by 35 U.S.C. 103 (c) statement. Therefore, rejection is maintained.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Correspondence***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis A. Ghali whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on (571) 272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Isis A Ghali/  
Primary Examiner, Art Unit 1611